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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/625,623 | 07/24/2003 | Masahiro Ohashi | 1743/222 | 8075 |

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| EXAMINER | |
|---|---|
| HARTMAN JR, RONALD D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2121 | |

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/625,623 | OHASHI ET AL. | |
| | Examiner | Art Unit | |
| | Ronald D Hartman Jr. | 2121 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/24/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 1-3 are presented for examination.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.32(c) may be used to overcome an actual or provisional rejection on a nonstatutory double patenting rejection provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.37(b).

The following citations are used to support the examiners position that the pending claims form a situation of double patenting over previously patented claims:

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. V. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)(holding that an earlier species disclosure in the prior art defeats and generic claim). This courts predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the

doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998)(affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)."(Eli Lilly and Company V Barr Laboratories, Inc., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (decided: May 30, 2001)

Claim 1 of the instant application is anticipated by patented claim 12 in that claim 12 of the patent contains all of the limitations of claim 1 of the instant application. Claim 1 of the instant application therefore is not patentably distinct from the earlier patented claim 12 and as such is unpatentable for obvious-type double patenting. In other words, pending claim 1 is generic to the species of the invention covered by claim 12 of the patent and as such, claim 1 is unpatentable over claim 12 of the patent because of obvious-type double patenting.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by McCreery et al., U.S. Patent No. 5,787,253.

As per claim 1, McCreery teaches a message filter circuit comprising:

- a message storing part for taking in and storing each of said message transmitted on a transmission line (e.g. packet capture

section; C4 L41-47), wherein each message includes an identifier indicating a message sending node and an identifier indicating a message receiving node (e.g. C4 L35-39);

- a registration part for registering data of message receiving conditions in advance (i.e. memory; C8 L45-46 and Figure 42 element 308 and C8 L50-52);
- a comparison part for comparing the identifiers with the conditions (e.g. C8 L41-50); and
- a message storing part for storing a message taken in based on the results of the comparison and for sending the stored message to an external circuit (e.g. raw packet data buffer; Figure 4b element 334 and C8 L66-C9 L5 and C9 L28-36).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCreery et al., as applied to claim 1 above, in view of Maria et al., U.S Patent No. 6,092,110.

As per claim 2, McCreery does not specifically teach a processor being used for the comparison part.

Maria teaches the use of a processor used as a comparison part for determining whether packets will be received (e.g. Figure 1 element 14, Figure 2 element 38 and C6 L5-16 and Claim 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a processor, as taught by Maria, for comparing the

contents of frames since both inventions are both directed towards analogous art, that is, they are both related to filter packets and the use of a processor would allow for a dedicated processor to accomplish the comparison in order to form a more efficient and quicker filtering process (e.g. C2 L38-40), and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCreery et al., as applied to claim 1 above, in view of Gandhi et al., U.S Patent No. 6,112,218.

As per claim 3, McCreery does not specifically teach programmable logic being used for the comparison part.

Gandhi teaches the use of a programmable logic being used for the comparison part in a digital filtering process (e.g. the combination of claims 9-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed for a programmable logic device to be used as the comparison part since it would afford the system of McCreery a more flexible approach for digitally filtering packets or frames since logic may be easily changes so that the filtering means is afforded greater flexibility and also allows for changes in the filtering process to be easy implemented by reprogramming the filtering process, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is 703-308-7001. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.
Examiner
Art Unit 2121

Anthony Knight
Supervisory Patent Examiner
Group 3600